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Please find below and/or attached an Office communication concerning this application or proceeding.

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PTOL-90A (Rev. 10/06)

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

MAILED

FEB 0 9 2007

GROUP 3600

Application Number: 09/909,439
Filing Date: July 19, 2001
Appellant(s): SELLERS ET AL.

Peter H. Priest
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/30/06 appealing from the Office action

mailed 6/02/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2002/0040339	Dahr et al.	10-2000
6,112,190	Fletcher	08-1997

Disclosed Prior Art (specification, p. 1, line 14 - p. 2, line 6)

Myers (TA Myers & Co. Real Estate Problem Loans: Workout Strategies and

Procedures. Dow Jones-Irwin. 1990. pp. 5 - 30)

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.

2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating
       obviousness or nonobviousness.

Claim 1-3, 5, 6-8 and 10 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Dhar (US PG Pub. 2002/0040339 A1) in view of Disclosed Prior Art

(see specification, p. 1, line 14 – p. 2, line 6) and Myers (TA Myers & Co. *Real Estate*

Problem Loans: Workout Strategies and Procedures. Dow Jones-Irwin. 1990. pp. 5 –

30).

Regarding Claim 1, Dhar discloses a system comprising:

- a network of personal computers (clients) connected into a network

   administered by a central server computer (web server). ("The web server

   is in network communication with the Internet. The web server provides

   the Internet interface for the client's web browser. Specifically, the web

   server hosts dynamic web pages and provides an interface for clients to

   interact with the application server and the database server." - see p. 1,

   para. 17);

- each personal computer in the network including a network interface (web

   interface) for transmitting servicer (client) inputs to, and receiving outputs

   from, the server computer. ("Each request from the client proceeds

   through the web server, which transmits the required information to the

   application server." – see p. 1, para. 18. "Assuming that the borrower

   scores high enough to qualify for one or more of the instant offer loans,

the system compiles a list of instant offers for that consumer and displays them on a web page for the consumer's review." – see p. 9, para. 104);

▫ each personal computer in the network further including display screens for receiving inputs from, and providing outputs to, a servicer (client), including inputs and outputs relating to a proposed loan. ("...a website interface providing a credit application form for a consumer to complete, the website interface providing a field for the consumer to select a category of loan offerings.." – see Claim 1. A display screen would be inherent in collecting input through a website interface. "Assuming that the borrower scores high enough to qualify for one or more of the instant offer loans, the system compiles a list of instant offers for that consumer and displays them on a web page for the consumer's review." – see p. 9, para. 104);

▫ the central server computer (application server) having a central processing unit (workflow/decision engine) that runs automatic loan decision analysis software and has access to electronically stored information relating to the borrower and other information necessary for analysis of a decision (credit information dataset) for approval, deferral or rejection of the proposed loan (see instant offer, further review, and no offer – see figure 3). ("When the lending institution receives the application data, the back-end loan workflow engine is activated instantly to perform automatic decision analysis for credit scoring, ratio analysis and other

credit checks to meet the selection criteria of each financial institution." –

see p. 4, para. 41. "The workflow engine accepts web-based loan

applications, processes the loan applications programmatically, and

renders a loan decision within seconds." – see abstract. "...renders an

programmatic loan decision without human intervention..." – see abstract

– establishing that the decision is automatic. "In the United States, credit

bureaus, such as TRANSUNION, EQUIFAX and the like, maintain credit

information relating to each consumer according to his or her social

security number. Creditors can access credit information relating to credit

applicants by accessing secure databases of these credit bureaus." – see

p. 8, para. 86 – 88);

▫ the central server computer (application server) being operative, under the

control of the workout analysis software (workflow/decision engine), to

analyze details of the proposed loan in light of criteria (checklist)

established by the lender, the analysis taking into account concessions

that must be made in order to secure the proposed loan. ("Offer details

maybe renegotiated online by clicking a link to communicate directly with

the financial institution." – see p. 12, para 141 – It is inherent in

renegotiation that concessions are made to secure the goal); and

▫ the central server computer transmitting to the borrower, automatically

over the network, automatic approval of the proposed loan if the proposed

loan meets the criteria (checklist) established by the lender and, if the

proposed loan does not meet the criteria established by the lender,

providing further instructions to the borrower (rejection notice). ("The

workflow engine uses <u>checklists</u> to evaluate loan applications." – see

abstract. "If the bank rejects the application, <u>a rejection notice is sent</u> to

the applicant." – see p. 9, para. 0100. "...renders an programmatic loan

decision without human intervention..." – see abstract – establishing that

the decision is automatic).

Dhar does not teach a system comprising:

- inputs from and outputs to, a servicer <u>on behalf of a financially troubled</u>

  <u>borrower</u>, including inputs and outputs relating to a proposed loan <u>workout</u>

  <u>to resolve a problem status of an existing loan obligation of the financially</u>

  <u>troubled borrower;</u>

- the central server computer having a central processing unit that runs

  automatic <u>workout</u> approval analysis software and has access to

  electronically stored information related to the <u>financially troubled borrower</u>

  <u>and existing loan information</u> necessary for analysis of a decision for

  approval, deferral or rejection of the proposed <u>workout</u>; and

- the central server computer being operative, under the control of the

  <u>workout</u> analysis software, to analyze details of the proposed <u>workout</u> in

  light of criteria established by a mortgage insurer, <u>the analysis taking into</u>

  <u>account concessions that must be made in order to accomplish the</u>

  <u>proposed workout, the analysis further taking into account financial</u>

conditions related to the borrower and the property influencing the

desirability of making concessions necessary to accomplish the proposed

workout and the likelihood of success of resolving the problem status of

the loan through the proposed workout.

Disclosed Prior Art discloses:

   □   inputs from and outputs to, a servicer (workout representative) on behalf

of a financially troubled borrower, including inputs (borrower completed

workout proposal) and outputs (requesting of more borrower information)

relating to a proposed loan workout to resolve a problem status of an

existing loan obligation of the financially troubled borrower. (see p. 1, lines

20 – 25).

Myers discloses a system comprising:

   □   workout analysis has access to information related to the financially

troubled borrower (evaluation of borrower) and existing loan information

(pertinent information). (see pp. 15 – 20); and

   □   the analysis taking into account concessions that must be made in order

to accomplish the proposed workout, the analysis further taking into

account financial conditions related to the borrower and the property

influencing the desirability of making concessions necessary to

accomplish the proposed workout and the likelihood of success of

resolving the problem status of the loan through the proposed workout.

(see p. 19 – 30)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Dhar by incorporating the established loan workout analysis, as disclosed by Disclosed Prior Art and Myers, into the automated loan decision analysis software and workflow/decision engine, as disclosed by Dhar, to provide a faster and automated system through which to run loan workouts, and, as disclosed by Dhar, produce an automatic decision.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Dhar and Disclosed Prior Art by incorporating the ability to make concessions to increase the likelihood of success of securing the proposed workout, as disclosed by Myer, to increase the number of tasks that the automated workout system can manage without human interaction, such as through Dhar's usage of "different combinations of parameters" (see Dhar, p. 9, para. 98).

Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have automated these processes, since it has been held that broadly providing a mechanical or automatic means to replace manual activity that accomplishes the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Regarding Claim 2, Dhar discloses a system, wherein the personal computers are connected into the network using an Internet connection. ("The web server is <u>in</u> <u>network communication with the Internet</u>. The web server provides the Internet interface for the client's web browser. Specifically, the web server hosts dynamic web pages and

provides an interface for clients to interact with the application server and the database

server." - see p. 1, para. 0017).

Regarding Claim 3, Dhar discloses a system, wherein the network interface is

web-based. ("The web server is in network communication with the Internet. The web

server provides the Internet interface for the client's web browser. Specifically, the <u>web</u>

<u>server hosts dynamic web pages and provides an interface for clients</u> to interact with

the application server and the database server." - see p. 1, para. 0017).

Regarding Claim 5, Dhar discloses a system, wherein if the user inputs fail to

satisfy predetermined guidelines (checklists), the user receives a message informing

the user that the system cannot be used. ("Rejection notice sent to applicant" – see

figure 7, 114, 116, 118 and 120).

Regarding Claims 6 – 8 and 10, further method claims would have been

obvious from system claims rejected above, Claims 1 – 3 and 5, respectively, and are

therefore rejected using the same art and rationale.

Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Dhar, Disclosed Prior Art and Myers, as in Claim 1 and 6 above, in further view of

Fletcher (US Patent 6,112,190).

Regarding Claim 4, neither Dhar, Disclosed Prior Art nor Myer teach a system,

wherein:

       □ <u>one or more of the display screens presents to a user a menu of</u>

          <u>predefined workout types and wherein the system allows the user to</u>

> choose a workout type by making an appropriate selection from the menu
>
> of predefined workout types.

Fletcher discloses a system wherein:

> ▫ one or more of the display screens presents to a menu (drop-down menu)
>
> of predefined analysis types and wherein the system allows the user to
>
> choose an analysis type by making an appropriate selection from the
>
> menu (drop-down menu) of predefined analysis types. (see figure 14).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to have modified the automated loss mitigation loan workout

system, as disclosed by Dhar, Disclosed Prior Art and Myer, in combination, to provide

a menu of predefined analysis types for selection among, as disclosed by Fletcher, to

utilize a common and standard software feature to create an easier to utilize graphic

user interface.

Regarding Claim 9, further method claim would have been obvious from system

claim rejected above, Claim 4, and is therefore rejected using the same art and

rationale.

(10) Response to Argument

Claim 1 - Analogous Arts

As a preliminary matter, Examiner asserts that the prior art references (Dhar,

Myers and Disclosed Prior Art) are valid under the analogous arts test. The Courts have

stated that to be utilized "as a basis for rejection of the applicant's invention, the

reference must either be in the field of the applicant's endeavor or, if not, then be

reasonably pertinent to the particular problem with which the inventor was concerned."

In re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992). As such "it is necessary to consider

"the reality of the circumstances" -- in other words, common sense -- in deciding in

which fields a person of ordinary skill would reasonably be expected to look for a

solution to the problem facing the inventor." In re Wood, 599 F.2d 1032, 1036 (CCPA

1979). Examiner asserts that based upon common sense, the field of the references

and/or the problem the inventor was concerned about, that the cited prior art references

would have been utilized by a skilled artisan in the art, as all prior art references relate

to processing loan applications and/or processing workout loans.

Claim 1 – Claim Limitations and Obviousness of Combination

For the ease of the Board, Examiner presents a mapping of the claim limitations

of the Claim 1 to the applicable prior art references.

Phrase #	Claim 1	Dhar	Disclosed Prior Art	Myers
1	a system for automatically generating loan workout decisions comprising:	a system for automatically generating loan decisions comprising:	workout loans	workout loans

2	a network of personal computers connected into a network administered by a central server computer	a network of personal computers (clients) connected into a network administered by a central server computer (web server). (see p. 1, para. 17);		
3	each personal computer in the network including a network interface for transmitting servicer inputs to, and receiving outputs from, the server computer.	each personal computer in the network including a network interface (web interface) for transmitting servicer (client) inputs to, and receiving outputs from, the server computer. (see p. 1, para. 18 & p. 9, para. 104);		
4	each personal computer in the network further including display screens for receiving inputs from, and providing outputs to, a servicer on behalf of a financially troubled borrower, including inputs and outputs relating to a proposed loan obligation of the financially troubled borrower.	each personal computer in the network further including display screens for receiving inputs from, and providing outputs to, a servicer (client), including inputs and outputs relating to a proposed loan. (see Claim 1 & p. 9, para. 104);	inputs from and outputs to, a servicer (workout representative) on behalf of a financially troubled borrower, including inputs (borrower completed workout proposal) and outputs (requesting of more borrower information) relating to a proposed loan workout to resolve a problem status of an existing loan obligation of the financially troubled borrower. (see p. 1, lines 20 – 25).	

| 5 | the central server computer having a central processing unit that runs automatic workout approval analysis software and has access to electronically stored information related to the financially troubled borrower and existing loan information necessary for analysis of a decision for approval, deferral or rejection of the proposed workout; and | the central server computer (application server) having a central processing unit (workflow/decision engine) that runs automatic loan decision analysis software and has access to electronically stored information relating to the borrower and other information necessary for analysis of a decision (credit information dataset) for approval, deferral or rejection of the proposed loan (see instant offer, further review, and no offer – see figure 3). (see p. 4, para. 41; abstract; p. 8, para. 86 – 88); | | workout analysis has access to information related to the financially troubled borrower (evaluation of borrower) and existing loan information (pertinent information). (see pp. 15 – 20); and |

6	the central server computer being operative, under the control of the workout analysis software, to analyze details of the proposed workout in light of criteria established by a mortgage insurer, the analysis taking into account concessions that must be made in order to accomplish the proposed workout, the analysis further taking into account financial conditions related to the borrower and the property influencing the desirability of making concessions necessary to accomplish the proposed workout and the likelihood of success of resolving the problem status of the loan through the proposed workout.	the central server computer (application server) being operative, under the control of the workout analysis software (workflow/decision engine), to analyze details of the proposed loan in light of criteria (checklist) established by the mortgage insurer (bank and/or financial insitution), the analysis taking into account concessions that must be made in order to secure the proposed loan. (see p. 12, para 141); and		

7	the central server computer transmitting to the borrower, automatically over the network, automatic approval of the proposed loan if the proposed loan meets the criteria established by the mortgage insurer and, if the proposed loan does not meet the criteria established by the mortgage insurer, providing further instructions to the borrower.	the central server computer transmitting to the borrower, automatically over the network, automatic approval of the proposed loan if the proposed loan meets the criteria (checklist) established by the mortgage insurer (bank and/or financial insitution) and, if the proposed loan does not meet the criteria established by the mortgage insurer . (bank and/or financial insitution) providing further instructions to the borrower (rejection notice). (see p. 9, para. 0100 & abstract).		the analysis taking into account concessions that must be made in order to accomplish the proposed workout, the analysis further taking into account financial conditions related to the borrower and the property influencing the desirability of making concessions necessary to accomplish the proposed workout and the likelihood of success of resolving the problem status of the loan through the proposed workout. (see p. 19 – 30)

In response to appellant's piecemeal analysis of the references, "one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references." *In re Keller, Terry, and Davies, 208 USPQ 871, 882 (CCPA 1981).* In the instant case, appellant refutes each prior art reference individually, rather than viewing them in combination, in light of the totality of their combined teachings.

Briefly, appellant refutes Dhar, an automated loan processing system, for not teaching workout loans and refutes Myers, non-patent literature concerning workout loans, for not being an automated system.

In regards to Dhar, appellant attempts to distinguish Dhar from the present invention, as Dhar "is directed toward evaluating new applications for credit" while the present invention is directed toward "resolv[ing] a problem status of an existing loan." Appellant also asserts that Dhar, is directed toward initiating new lender/borrower relationships, thereby failing to disclose a pre-existing lender/borrower relationship, as claimed in Claim 1.

Examiner asserts that Dhar is directed toward the automated evaluation of loan applications. And when the problem status of an existing loan is resolved through the issuance of a workout loan, a new loan is thereby issued encompassing all the remaining debt of the prior existing loan. As such, Examiner asserts that Dhar is a particularly relevant prior art reference.

Disclosed Prior Art and Myers disclose that utilization of workout loans to resolve problematic existing loans, thereby establishing a prior existing lender/borrower analysis, and that the analysis utilized to evaluate workout loans are old and well known in the art.

Examiner asserts that when Dhar, which discloses automatically evaluating a loan application, is analyzed in conjunction with Myers and Disclosed Prior Art, which discloses the analysis and processing of workout loans, that the prior art does disclose all claim limitations and that the instant invention is obvious.

Appellant specifically states numerous information types that are utilized in the evaluation of workout loans but would not be utilized in new loan applications and, therefore, not disclosed by Dhar. However, such specific information is not claimed in the application. Claim 1 merely claims "electronically stored information relating to the financially troubled borrower and existing loan related information necessary for analysis."

Myers discloses that when evaluating a workout loan as a refinancing alternative that there is an "Information-Gathering and Analysis" phase (see pp. 15 – 20) in which the "pertinent information" is gathered (see p. 15). Myers further discloses "[t]he purpose of the information-gathering process is to provide the lender with a clear indication as to which of the preceding alternatives should be selected and the potential consequences associated with the implementation of that alternative," (see p. 16) and that such information should include "[I]nformation relating to the evaluation of the borrower." (see p. 16). Examiner asserts that such disclosure reads on the claim language actually utilized in Claim 1 as Examiner is entitled to utilize the "broadest reasonable interpretation consistent with the specification during the examination of a patent application since the applicant may then amend his claims." *See In re Prater and Wei, 162 USPQ 541, 550 (CCPA 1969).*

In regard to Myers, appellant asserts that Myers is "simply a lender's guidebook to a uniform approach to loan workouts" and fails to teach the automation of the disclosed workout loan methodology. However, Examiner is unsure how Myers' status as "simply a lender's guidebook" negates its value as a relevant prior art reference and

asserts that when read in combination with Disclosed Prior Art Dhar, an automated loan

system, Myers does disclose the claim limitations concerning automation.

In addition to being an "Automated Loan Processing System and Method" (see

title), Dhar also discloses that "[t]echnology has changed the landscape of the financial

services industry such that agents play an increasingly shrinking role in marketing the

financial products to consumers. As the Internet has grown in popularity, consumers

shop for financial services over the Internet without the aid of an agent... A growing

number of online companies also provide loan services; however, these online

companies currently fall short of fully automating the loan process." (see Dhar, p. 1,

para. 4 – 5). While Dhar states that full automation had not yet been achieved at the

time of filing (October 2, 2000), that does not mean that impending automation was not

obvious.

Appellant also asserts that Myers fails to address "analysis of a workout proposal

in light of criteria established by a mortgage insurer." However, once again, appellant is

refuting the prior art references piecemeal, as Myers discloses the analysis for workout

loan approval while Dhar discloses analysis of a loan proposal in light of criteria

contained within its workflow/decision engine (see fig. 3). Furthermore, Examiner

asserts that "established by mortgage insurer" has been given the "broadest reasonable

interpretation" and does encompass the criteria established by the "banks or financial

institutions to customize workflow parameters, define checklists and define selection

criteria for lending and deposit processes within the workflow engine," as disclosed by

Dhar (see p.3, para. 31). In the alternative, Examiner asserts that the party that

establishes the criteria within the system is immaterial and fails to distinguish the claims

from the cited prior art.

Appellant further attempts to distinguish Myers from the instant application by

stating that appears to be "*primarily directed* to borrowers engaged in the use of real

estate as a business enterprise, such as construction, property development, or rental

property" while instant application is directed toward "mortgage insurance which is

typically associated with the purchase or refinance of residential property by a

homeowner." (emphasis added). Therefore, appellant asserts that Myers "*tends* to

teach away" from the Examiner's combination. However, Examiner must assert that

examiner that disclosed examples and preferred embodiments do not constitute a

teaching away from a broader disclosure or non-preferred embodiments. *In re Susi, 169*

USPQ 423, 426 (CCPA 1971). Furthermore, the appellant's very language indicates the

weakness of this assertion as mortgage insurance "is *typically* associated" with

residential property while Myers is "*primarily* directed" to commercial property, so Myer

"*tends* to teach away" (emphasis added).

Appellant argues that prior art references fail to provide no suggestion or

motivation to combine and/or automate. However, the Courts have stated that "[a]

suggestion, teaching, or motivation to combine the relevant prior art teachings does not

have to be found explicitly in the prior art, as the teaching, motivation, or suggestion

may be implicit from the prior art as a whole, rather than expressly stated in the

references...The test for an implicit showing is what the combined teachings, knowledge

of one of ordinary skill in the art, and the nature of the problem to be solved as a whole

would have suggested to those of ordinary skill in the art... there must be some

articulated reasoning with some rational underpinning to support the legal conclusion of

obviousness." *In re Kahn, 78 USPQ2d 1329, 1336 (CA FC 2006).* Examiner asserts that

he has provided such "articulated reasoning" to support the legal conclusion of

obviousness.

Claim 1 – In re Venner

In response to appellant's argument concerning *In re Venner*, specifically

appellantt's argument that application of *In re Venner* was inappropriate and/or not

applicable, Examiner refutes such an assertion. The Courts have stated that "if a new

combination of old elements is to be patentable, the elements must cooperate in such

manner as to produce a new, unobvious, and unexpected result. It must amount to an

invention...In the absence of invention, utility and novelty are not sufficient to support

the allowance of claims for a patent... Furthermore, it is well settled that it is not

""invention"" to broadly provide a mechanical or automatic means to replace manual

activity which has accomplished the same result." *In re Venner and Bowser, 120 USPQ*

192, 194 (CCPA 1958).

Examiner asserts that the key phrasing in *In re Venner* is "broadly providing

mechanical and automated means". *In re Venner* is not stating that an invention that

makes possible the automation of a manual process is unpatentable, just that broadly

utilizing known mechanical and/or automated means to replace a known manual activity

is obvious. Neither *In re Venner* nor the appellant is inventing something that makes

automation possible. In both instances, the inventor is merely taking an existing

technology and utilizing it in its ordinarily designed fashion to replace manual activity in

a known manual process.

In *In re Venner*, a timer was being used to operate a mold apparatus, thus

replacing the human worker that would sit by the machine and monitor the mold

apparatus. *In re Venner* was not inventing a timer. *In re Venner* was not inventing the

molding process. *In re Venner* was merely utilizing existing technology, a timer, to

replace a known manual activity, monitoring the molding apparatus, and the existing

technology is performing its ordinary designed function, telling time.

In the instant case, appellant is utilizing an existing technology, a computer, to

replace a manual activity, performance of loan decision-making functions, and the

existing technology is performing its ordinary designed function, performing

computations and functions.

In the alternative, Examiner asserts that sufficient motivation to automate was

provided by Dahr (see, p. 1, para. 4 – 5), as discussed previously.

Claim 6

All argument(s) and/or rationale(s) set forth above with respect to earlier

addressed claim(s), Claim(s) 1, are hereby incorporated and/or reapplied so as to apply

to Claim(s) 6 where applicable.

Claims 2, 3, 5, 7, 8 and 10

All argument(s) and/or rationale(s) set forth above with respect to earlier

addressed claim(s), Claim(s) 1, are hereby incorporated and/or reapplied so as to apply

to Claim(s) 2, 3, 5, 7, 8 and 10 where applicable.

Examiner's Findings of Obviousness Not Contrary to Law

In response to appellant's argument concerning impermissible hindsight,

Examiner asserts that "[a]ny judgment on obviousness is in a sense necessarily a

reconstruction based upon hindsight reasoning, but so long as it takes into account only

knowledge which was within the level of ordinary skill at the time claimed invention was

made and does not include knowledge gleaned only from applicant's disclosure,

reconstruction is proper." *In re McLaughlin, 170 USPQ 209, 212 (CCPA 1971).*

In response to appellant's argument that prior art reference(s) teach away from

Examiner's interpretation, examiner asserts that disclosed examples and preferred

embodiments do not constitute a teaching away from a broader disclosure or non-

preferred embodiments. *In re Susi, 169 USPQ 423, 426 (CCPA 1971).* Examiner

asserts that, despite appellant's arguments to the contrary, there is nothing disclosed

within the prior art references that "teach away" from the combination of their various

teachings.

In response to applicant's argument that there is no suggestion to combine the

references, the Courts have stated that "[a] suggestion, teaching, or motivation to

combine the relevant prior art teachings does not have to be found explicitly in the prior

art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references...The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art... there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn, 78 USPQ2d 1329, 1336 (CA FC 2006)*. Examiner asserts that he has provided such "articulated reasoning" to support the legal conclusion of obviousness.

(11) Evidence Appendix
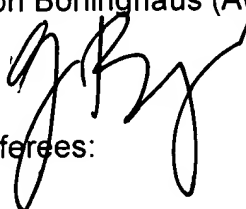
None

(12) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Jason Borlinghaus (AU 3693)

JMB
2/7/07

Conferees:
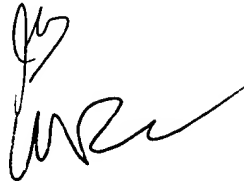
James Kramer

Vincent Millin